

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Claims 11-14 are pending in this application and stand rejected.

Independent claim 11 is amended to delete the term "prodrug". Support can be found in original claim 1. Claim 11 is also amended to recite that said compounds cannot be one in which, when n is 0, R² is OH and R¹, R³, R⁴ and R⁶ are H and R⁵ is ethyl. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977); Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984); M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2173.05(i), 2100-228. Support for amended claim 1 can be found in the specification, for instance, at page 1, lines 1-11 and original claim 4.

No new matter has been added.

II. ENABLEMENT REJECTION

Claim 11 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the terms "prodrugs thereof" for the reasons set forth in item 1 on pages 2-3 of the Office Action.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, the present amendment overcomes this rejection by canceling the term "prodrugs" from the claim. As such, the present amendment obviates the rejection. The rejection is thus untenable and should be withdrawn.

III. PRIOR ART REJECTIONS

A. Rejection over KORTING et al.

Claims 11-14 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by KORTING et al. (Arzneimittel-Forschung, 1954) for the reasons in items 3-5 on pages 3-4 of the Office Action.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicants have amended independent claim 11 to recite that said compounds cannot be one in which, when n is 0, R² is OH and R¹, R³, R⁴ and R⁶ are H and R⁵ is ethyl. In doing so, the present amendment excludes the adrenal derivative phenol, m-[2-(ethylhydroxyamino)ethyl] compound of KORTING et al. For this reason, the 102(b) anticipation rejection fails, because KORTING et al. fails to disclose each and every element of the claims. Thus, the compound of claim 11 is novel and patentable over KORTING et al.

Claims 12-14 depend, either directly or indirectly, on claim 11. Accordingly, these claims are also novel and unobvious over

KORTING et al. for the same reasons due to their dependency on claim 11.

Therefore the above-noted 102(b) anticipation rejection over KORTING et al. is untenable and should be withdrawn.

B. Rejection over KORTING et al. and DAVIDSON

Claims 11, 13, and 14 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over KORTING et al. in view of DAVIDSON (Florida State University, 1995-2000) for the reasons in items 9-11 on pages 5-6 of the Action.

This rejection is respectfully traversed.

It is well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

Again, claim 11 is amended to exclude the compound in KORTING et al. Accordingly, the compound relied upon by the Office in KORTING et al. has been disclaimed. For this reason, KORTING et al. fails to disclose or suggest each and every element of the claimed invention. Consequently, the combination

of KORTING et al. and DAVIDSON cannot render obvious the claimed invention.

Further, as acknowledged at page 5 of the Office Action, KORTING et al. fails to disclose or suggest treatment of disorders of the central and peripheral nervous system of claim 14.

For these reasons, claims 11, 13 and 14 are novel and unobvious over KORTING et al.

The secondary reference of DAVIDSON fails to remedy the above-noted deficiencies in KORTING et al. In this regard, DAVIDSON does not disclose a compound of claim 1.

Furthermore, there would have been no rationale to combine DAVIDSON with the teaching of KORTING et al. to arrive at the claimed invention with any reasonable expectation of success. In this regard, the cited prior art references never disclose or suggest that such compounds have any central nervous system (CNS) activity, such that they could be used to treat central and peripheral nervous system disorders as recited in claim 14.

Specifically, KORTING et al. was relied upon as disclosing an adrelin (epinephrine) derivative. DAVIDSON was relied upon as disclosing that epinephrine can stimulate the central nervous system. However, the claimed compounds have nothing to do with epinephrine. Indeed, it is known that epinephrine has no psychoactive effect and its known therapeutic use has nothing to do with the central nervous system pathologies of claim 14.

Instead, epinephrine has therapeutic use for treating cardiac arrest. In support thereof, Applicants have attached herewith relevant online Encyclopedia Wikipedia definitions for epinephrine and its therapeutic uses and the definition for Alzheimer's disease. However, such therapeutic use is not predictive of treating central and peripheral nervous system disorders as recited in claim 14. The biochemical basis of Alzheimer's disease (claim 14) and the mechanism underlying this pathology is not minimally dependent on epinephrine.

As such, it is respectfully submitted that one of ordinary skill in the art, upon reading the cited references, would have not been motivated to combine KORTING et al. and DAVIDSON and thereby modify the structure of the compounds in KORTING et al. to successfully arrive at the compounds of the present invention having the disclosed pharmacological activity. There would have been no reasonable expectation of success in doing so due to the lack of any teaching of such activity in the cited references. For this additional reason, it is respectfully submitted that the combination of KORTING et al. and DAVIDSON fails to disclose or suggest each and every element of the claimed invention. Therefore, claims 11-14 are novel and patentable over the combination of KORTING et al. and DAVIDSON.

Again, it is respectfully submitted that the claims exclude the compounds relied upon by the Office in KORTING et al. and DAVIDSON.

Therefore, the above-noted prior art rejections are untenable and should be withdrawn.

IV. CONCLUSION

Having addressed all the outstanding issues, the amendment is believed to be fully responsive. Therefore, it is respectfully submitted that the application is in condition for allowance and notice to that effect is hereby requested. If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

Online Encyclopedia Wikipedia definitions